

REMARKS

Applicant appreciates the time taken by the Examiner to review Applicant's present application. This application has been carefully reviewed in light of the Official Action mailed November 28, 2005. Claims 1-10, 13-21, and 23-27 have been amended and Claim 29 has been added. No new matter has been added. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 1, 3-5, 7, 13, 14, 17, 22 and 25 stand rejected as anticipated by U.S. Publication No. 2002/0068629 ("Allen").

The standard for "anticipation" is one of fairly strict identity. To anticipate a claim of a patent, a single prior source must contain all the claimed essential elements. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 U.S.P.Q.81, 91 (Fed.Cir. 1986); *In re Donahue*, 766 F.2d 531, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985), MPEP 2131. Furthermore, anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). Allen does not disclose each and every element set forth in the pending claims, some distinctions of which are set forth below.

Applicant respectfully submits that the Examiner has failed to establish that Allen anticipates the pending claims because Allen does not disclose each and every element of Claims 1, 3-5, 7, 13, 14, 17, 22 and 25. As will be shown in further detail below, Allen does not teach or suggest validating a transaction authorization token to authenticate a user and to authorize a secure transaction, where the validating is performed while the user is offline from the on-line service.

Claim 1 recites:

A method of conducting a secure transaction with an on-line service while offline comprising the steps of:

issuing a transaction authorization token to a user from an application server for the on-line service while the user is online with the on-line service;

preparing an off-line transaction object containing data to specify and request the secure transaction;

sending a message to the on-line service, said message containing the off-line transaction object and the transaction authorization token;

upon receipt of said message, the application server validating the transaction authorization token to authenticate the user and to authorize the secure transaction, wherein the application server performs said validating while the user is offline from the on-line service; and

executing the off-line transaction object if the secure transaction is authorized.

Claim 1 thus recites a method of conducting a secure transaction with an on-line service while offline which includes sending a message to the on-line service, said message containing the off-line transaction object and the transaction authorization token. Upon receipt of said message, the application server validating the transaction authorization token to authenticate the user and to authorize the secure transaction, where the application server performs said validating while the user is offline from the on-line service. Thus, the authorization token initially issued by the on-line service is used *inter alia* to authenticate the user. Consequently, the transaction with the on-line service can be completed without the user reauthenticating with the on-line service

Allen does not teach or suggest the claimed method of completing secure transactions with an on-line service while off-line from the on-line service. In particular, Allen does not disclose an authorization token used to authenticate the user. Allen discusses a method which enables a user to connect to a provider server to obtain a gaming application and a gaming token having a monetary value, which allows a user to play the game and change the value of the gaming token while off-line. The gaming token contains various fields that ensure the value of the gaming token was modified in a permitted matter. However, Allen teaches that a user must reconnect to the application server to redeem the token (Allen - Fig. 6). The gaming token is not the authorization token of the present invention as the gaming token is not used to authenticate the user (i.e., to redeem the gaming token the user must separately authenticate.).

Moreover, Claim 1 recites that the application server performs said validating while the user is offline from the on-line service. As shown in Fig. 6 of Allen, a user must connect to the provider server in order to upload and authenticate a token. Thus, in Allen, the step of validating occurs while the user is online with the application server. Therefore, Allen does not teach authenticating a user while the user is offline from the on-line service. Accordingly, withdrawal of the rejection and allowance of Claims 1, 3-5, 7, 13, 14, 17, 22 and 25 is respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 2, 9-12, 15, 16, 19-21, 23, 24 and 26-28 stand rejected as obvious over by U.S. Publication No. 2002/0068629 (“Allen”) in view of U.S. Publication No. 2002/0010638 (“Fischer”). To establish a *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03.

Applicant respectfully submits that the Examiner has failed to establish a *prima facia* case of obviousness as the references do not disclose, teach, or suggest all the claim limitations of dependent claims 2, 9-12, 15, 16, 19-21, 23, 24 and 26. As described above, Allen does not anticipate the claimed limitations. Further, there is no motivation to modify Allen such that the claimed limitations are met. Even so, Fischer can not remedy deficiencies of Allen such that their combination teaches the claimed method of conducting secure transactions with an on-line service while off-line from the on-line service.

In contrast to the claimed limitations, Fischer teaches a method for performing e-commerce which includes creating an order-list in an off-line environment, sending the order list to the vendor, making the order list available to the user through a real-time connection between the user and the vendor, and enabling the user to review and approve the order list during the real-time connection (Fischer – abstract). Thus, Fischer requires the user to go on-line with the vendor to approve the order. Consequently, Fischer does not and cannot remedy deficiencies in Allen such that their combination teaches the claimed validating a transaction authorization token to authenticate the user while the user is offline and where the application server performs said validating while the user is offline from the on-line service. At least because Fischer requires the user to connect to the vendor to approve the order list, Fischer does not and cannot remedy the deficiencies of Allen such that the claimed limitations are taught. For example, Fischer requires the user to return on-line. Therefore, the claimed limitations are not obvious in view of Allen and Fischer. Accordingly, Applicant respectfully requests withdrawal of the § 103 rejections and allowance of Claims 2, 8, 9-12, 15, 16, 18, 19-21, 23, 24 and 26-28.

Added Claims

Claim 29 has been added. Claim 29 recites the limitation that the user is not required to be online with the on-line service for any one or more of the group comprising: said preparing, said sending, said receiving, or said executing, where said preparing comprises preparing an off-line transaction object containing data to specify and request the secure transaction; where said sending comprises sending a message to the on-line service, said message containing the off-line transaction object and the transaction authorization token; where said receiving comprises receiving said message, and upon receipt of said message, the application server for the on-line service validating the transaction authorization token to authenticate the user and to authorize the secure transaction; and where said executing comprises executing the off-line transaction object upon validation of the transaction authorization token.

Claims 29 is supported by the specification and thus does not present new matter. For example, page 4, lines 9-12 of the Specification recites, "while not logged in to the application server, the user prepares a transaction for entry into the application server. Thereafter, the end user transmits the transaction object and the token to the application server as an email message, without the necessity of logging back onto the application server."

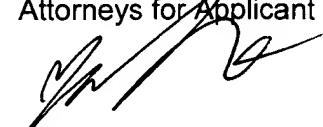
Further, the added claims are patentably distinct. The instant invention recites obtaining an authorization token while online with a server and, while offline, subsequently preparing and sending the authorization token and a transaction object to the server in a message (e.g., e-mail message) such that the message is received and executed without requiring the user to return online. Using the claimed authorization token, the transaction object of the instant invention can be executed without requiring the user to reconnect to the server. In contrast to the limitations of the pending claims, Allen teaches obtaining a token while on-line with a provider server, using the token while off-line from the provider server, and subsequently redeeming the token by reconnecting to the provider server.

Applicant has now made an earnest attempt to place this case in condition for allowance. Other than as explicitly set forth above, this reply does not include an acquiescence to statements, assertions, assumptions, conclusions, or any combination thereof in the Office Action. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests full allowance of Claims 1-29. The Examiner is invited to telephone the undersigned at the number listed below for prompt action in the event any issues remain.

The Director of the U.S. Patent and Trademark Office is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 50-3183 of Sprinkle IP Law Group.

Respectfully submitted,

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Date: **February 28, 2006**

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